

REMARKS

Claims 1-5, 7-8 and 10-22 were presented for examination, and all claims were rejected. Upon entry of the present amendment, claims 1-5, 7-8 and 10-22 are presented for examination, of which claims 1, 12 and 17-20 are independent. Applicants submit that claims 1-5, 7-8 and 10-22 are in condition for allowance.

The following comments address all stated grounds of rejection. Applicants traverse all rejections and urge the Examiner to pass the claims to allowance in view of the remarks set forth below.

CLAIM REJECTIONS UNDER 35 U.S.C. § 101

I. Claims 1-5, 7-8 and 10-11 rejected under 35 U.S.C. § 101

Claims 1-5, 7-8 and 10-11 are rejected under 35 U.S.C. § 101 because the Examiner contends that the claim as a whole is directed to an abstract idea. Claim 1 is independent and claims 2-5, 7-8 and 10-11 depend on claim 1. Applicants respectfully traverse this rejection and submit that these claims are directed to statutory subject matter.

Under the “machine-or-transformation” test of In Re Bilski, claimed subject matter is patentable under 35 U.S.C. §101 if “(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.” 545 F.3d 943, 954 (CAFC, 2008). Claim 1 is tied to a particular machine. First, claim 1 recites all acts of the method being performed within or by the computer-based management system. Secondly, the job descriptions created within instance(s) of interface(s) of the computer-based management system comprise a set of components for accessing an online database for client-related information. As such, within portions of the computer-based management systems, components are used to access an

online database with client information to create job descriptions. Thus, as the claimed subject matter is directed to developing or creating job descriptions and such job descriptions: i) are created or developed within an instance of an interface of the computer-based management system and ii) comprise components for accessing an online database, the claimed subject matter is more than sufficiently tied to a particular machine to satisfy that prong of the Bilski test.

Moreover, the subject matter of claim 1 does not fall into any of the judicial exceptions of an abstract idea, law of nature or natural phenomenon. 35 U.S.C. § 101. defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent: processes, machines, manufactures and compositions of matter. The subject matter courts have found to be outside of, or exceptions to, the four statutory categories of invention is limited to abstract ideas, laws of nature and natural phenomena. These three exclusions recognize that subject matter that is not a practical application or use of an idea, a law of nature or a natural phenomenon is not patentable. See, e.g., *Rubber-Tip Pencil Co. v. Howard*, 87 U.S. (20 Wall.) 498, 507 (1874) ("idea of itself is not patentable, but a new device by which it may be made practically useful is"); *Mackay Radio & Telegraph Co. v. Radio Corp. of America*, 306 U.S. 86, 94, 40 USPQ 199, 202 (1939) ("While a scientific truth, or the mathematical expression of it, is not patentable invention, a novel and useful structure created with the aid of knowledge of scientific truth may be."); *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759 ("steps of 'locating' a medial axis, and 'creating' a bubble hierarchy . . . describe nothing more than the manipulation of basic mathematical constructs, the paradigmatic 'abstract idea'"). For claims including such excluded subject matter to be eligible for patent protection, the claim must be for a practical application of the abstract idea, law of nature, or natural phenomenon. *Diehr*, 450 U.S. at 187, 209 USPQ at 8

("application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection."); *Benson*, 409 U.S. at 71, 175 USPQ at 676 (rejecting formula claim because it "has no substantial practical application").

The subject matter of claim 1 does not fall into the judicial exception of an abstract idea. The fact that the Examiner contends that portions of the method may be performed by a user does not render the claim as a whole an abstract concept. Regardless if the computer based management system received input from a user, claim 1 is still directed to a practical, functional and palpable application of using interfaces and components of a computer based management system to create or develop job descriptions. (see In Research Corp. Technologies v. Microsoft Corp., No. 2010-1037 (Fed. Cir. Dec. 8, 2010) - the Federal Circuit describing the invention as presenting "functional and *palpable applications* in the field of computer technology." and "inventions with *specific applications or improvements to technologies in the marketplace* are not likely to be so abstract that they override the statutory language and framework of the Patent Act." *Id.* (emphasis added).) As the subject matter of claim 1 is a specific application of technology not directed to abstract ideas and thus does not fall into any judicially created exception, the subject matter of claim 1 is directed to statutory subject matter.

For at least the above discussed reasons, Applicants submit that claim 1 is directed to patent eligible subject matter under 35 U.S.C. §101. Claims 2-5, 7-8 and 10-11 depend on and incorporate all of the patent eligible subject matter of claim 1. Thus, Applicants submit that claims 2-5, 7-8 and 10-11 are also patent eligible under 35 U.S.C. §101. Accordingly, Applicants request the Examiner to withdraw the rejection of claims 11-20 under 35 U.S.C. § 101.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

II. Claims 1-5, 7-8, 10-11 and 17-18 rejected over Roy, Almog and Balabine

Claims 1-5, 7-8, 10-11 and 17-18 stand rejected under 35 U.S.C. 103(a) as unpatentable over Roy et al. (US Pub. No. 2002/0069080) (hereinafter “Roy”) in view of Almog et al. (US Pub. No. 2002/0002479) (hereinafter “Almog”) further in view of Balabine et al. (US 5,937,406) (hereinafter “Balabine”) and in view of U.S. Patent No. 6,993,723 to Danielson et al. (“Danielson”). Claims 1, 17 and 18 are independent. Claims 2-5, 7-8 and 10-11 depend on and incorporate all of the patentable subject matter of independent claim 1, as amended. Applicant traverses this rejection and submit that Roy, Almog and Balabine, alone or in combination, fail to teach or suggest each and every element of the claims.

A. Independent Claims 1, 17 and 18 Patentable over Roy, Danielson, Almog and Balabine

To establish a prima facie case of obviousness, the prior art references, either alone or in combination, must teach or suggest each and every limitation of the claims.

Claims 1, 17 and 18 recite in part:

permitting, within another instance of the interface of the computer-based management system, a second user to create, interactively with a recruitment specialist during a job description development process, a second job description based upon the first job description

....the first job description comprising a first set of componentsfor accessing an online database; and

...the second job description comprising a second set of components ...for accessing the online database ...

Applicant submits that the combination of Roy, Danielson, Almog and Balabine fails to teach or suggest at least the above features of the claimed invention.

The Examiner relies on Roy and Danielson for the above features of the claimed invention while citing Almog and Balabine for other purposes. For working with a recruitment specialist during a job description development process, the Examiner cites paragraphs 134 and 145 of Roy. However, paragraph 134 only describes a client, such as an employer, submitting job description information or entering such information while paragraph 145 merely describes that the recruiter controls the finalization and approval of the job description. Roy does not offer any description of the employer and recruiter working together to create the job description. Instead, in Roy, the employer enters the information and the recruiter thereafter controls and approves the information. Accordingly, the Examiner admits that Roy does not describe an interactive process between a user and recruitment specialist and cites Danielson for this purpose. Although Danielson describes a groupware tool for users to work on the same document, there is no teaching or suggest in either Danielson or Roy on how from one job description another job description is created interactively with another user and in which such job descriptions comprise components for accessing an online database for client-related information. Furthermore, there is no teaching or suggestion in Danielson to include such components in its groupware tool nor is there any description of how two users via such a groupware tool would create a job description from another job description that includes such components.

As at least one of Roy or Danielson fails to teach the respective elements of the claims for which it was cited by the Examiner, the combination of Roy and Danielson fails to teach or suggest these features of the claimed invention. As Almog and Balabine were cited for other purposes, neither Almog nor Balabine bridge the deficiencies in the combination of Roy and Danielson. As such, the combination of Roy, Danielson, Almog and Balabine fails to teach or suggest each and every element of the claimed invention.

Because the combination of Roy, Danielson, Almog and Balabine fails to teach or suggest each and every element of claims 1, 17 and 18, Applicant submits that claims are 1, 17 and 18 are patentable and in condition for allowance. Claims 2-5, 7-8 and 10-11 depend on and incorporate all of the patentable subject matter of independent claim 1. Therefore, Applicant submits that claims 2-5, 7-8 and 10-11 are also patentable and in condition for allowance. Accordingly, Applicant requests the Examiner to withdraw the rejection of claims 1-5, 7-8 and 10-11 under 35 U.S.C. § 103.

III. Claims 12-16 and 19-22 rejected over Roy, Danielson and Balabine

Claims 12-16 and 19-22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Roy in view of Danielson et al. (US 6,993,723) and further in view of Balabine. Amended claims 12, 19 and 20 are independent. Claims 13-16 and 21 depend on and incorporate all of the patentable subject matter of independent claim 12 as amended. Claim 22 depends on and incorporates all of the patentable subject matter of independent claim 20 as amended. Applicant traverses this rejection and submits that Roy, Danielson and Balabine, alone or in combination, fail to teach or suggest each and every element of the claims as amended.

A. Independent Claims 12, 19 and 20 Patentable over Roy, Danielson and Balabine

To establish a prima facie case of obviousness, the prior art references, either alone or in combination, must teach or suggest each and every limitation of the claims.

Claims 12, 19 and 20 recite in part:

receiving, during the job description development process by the requirements specialist working interactively with the client, through another instance of the interface of the computer-based management system, real-time feedback from the client on the portion of the job description;

.... storing the....portion of a job description in the online database as at least one object-oriented object.

Applicant submits that the combination of Roy, Danielson and Balabine fails to teach or suggest at least the above feature of the claimed invention.

The combination of Roy, Danielson and Balabine fails to teach or suggest receiving by the requirements specialist real-time feedback from the client during a job description development process that is interactive between the client and the requirements specialist. The Examiner relies on Roy and Danielson for these features while citing Balabine for other purposes. For the reasons discussed above in connection with independent claim 1, Roy does not teach or suggest a client working interactively with a requirements specialist. Danielson does not bridge these deficiencies of Roy because Danielson fails to describe an instance of an interface for interactively creating job descriptions that are stored via object-oriented objects. Danielson's groupware does not describe an interface for creating job descriptions that comprise objected oriented objects. In Danielson, one can work on a document while messaging another person but that does not equate to a job description development interface for creating job descriptions

interactively with object-oriented objects. Therefore, the combination of Roy, Danielson and Balabine fails to teach or suggest each and every element of the claimed invention.

Because the combination of Roy, Danielson and Balabine fails to teach or suggest each and every element of claims 12, 19 and 20, Applicant submits that claims 12, 19 and 20 are patentable and in condition for allowance. Claims 13-16 and 21 depend on and incorporate all of the patentable subject matter of independent claim 12. Claim 22 depends on and incorporates all of the patentable subject matter of independent claim 20. Therefore, Applicant submits that claims 13-16 and 21-22 are also patentable and in condition for allowance. Accordingly, Applicant requests the Examiner to withdraw the rejection of claims 12-16 and 19-22 under 35 U.S.C. § 103.

CONCLUSION

In light of the aforementioned arguments, Applicant contends that each of the Examiner's rejections has been adequately addressed and all of the pending claims are in condition for allowance. Accordingly, Applicant respectfully requests reconsideration, withdrawal of all grounds of rejection, and allowance of all of the pending claims.

Should the Examiner feel that a telephone conference with Applicant's representative would expedite prosecution of this application, the Examiner is urged to contact Applicant's representative at the telephone number identified below.

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Respectfully submitted,
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